

Appl. No. 10/797,981
Docket No. 9576
Amdt. Dated February 11, 2010
Reply to Office Action mailed on August 11, 2009
Customer No. **27752**

REMARKS

Claims 1-6, 9, 15, 16, 18, 19, and 21 are currently pending in this application. Claim 17 is canceled herein without admission or prejudice. Claims 1, 3-6, 9, 15, and 19 are amended herein for clarification. New claim 21 has been added. Support for new claim 21 and the amendments to claims 1, 3-6, 9, 15, and 19 are believed to be fully supported in the application, for example, on page 8, lines 15-20. It is believed that no new matter has been entered.

Claim Objections

Claim 1 is objected to because of the following informality - Applicant has an acronym, "BYV", within the claim used as a functional limitation of the claim. Claims 1 and 19 have been amended to correct this informality, thus withdrawal of this objection is respectfully requested.

Rejections under 35 USC § 112

Written Description 112, ¶ 1

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. This rejection is respectfully traversed.

As stated in MPEP 2163.04, "[a] description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption." *See, e.g., In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). "The examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The examiner has the initial burden of presenting **by a preponderance of evidence** why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims." *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 97 (CCPA 1976).

In rejecting a claim, the examiner must set forth express **findings of fact** which support the lack of written description conclusion. These findings should:

(A) Identify the claim limitation(s) at issue; and

(B) Establish a prima facie case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed.

Here, the Examiner has provided no factual support to show that the present inventors were not in possession of the invention as defined by claim 1. The Examiner's argument is factually unsupported conjecture, and all claims are fully supported by the application as filed. Elements a-d of claim 1 are supported by claim 1 as originally filed and the specification. (*See* page 2 line 27- page 3, line 2; page 3, lines 19-24; page 5, lines 3-5; and page 8, lines 15-20). Moreover, Table 1 provides specific examples of these inventive compositions. (*See* pages 14-15). Furthermore, the recitation of the Average Lather Volume is supported in the application on page 13, lines 27-30, and the method for calculating the Average Lather Volume via the Lather Volume test is described in detail on page 13, lines 10-24. The claimed recitation of the Brookfield Yield Value is also well supported in the application on page 4, lines 26-28, and the method for calculating the Brookfield Yield Value is shown in detail on page 4, lines 14-22. Based on this support, the disclosure demonstrates that applicant had possession of the invention as of the filing date.

Despite support for all claim elements, the Examiner states that the instant specification does not disclose how the structural limitations of the claimed invention correlate to the recited function. In short, the Examiner is attempting to shift the burden without first providing evidence or sufficient reasoning why the description is inadequate. As shown above, the disclosure states that the claimed compositions achieve the claimed Average Lather Value and the claimed Brookfield Yield Value. Furthermore, the specification also states that suspension ability (as measurable by the Brookfield Yield Value) and lathering ability (as measurable by the Average Lather Value) are desirable properties achieved by the present composition. (page 2, lines 3-16). Thus, the specification provides a correlation between the structure of the claimed lathering

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personal cleansing composition and the claimed Brookfield Yield Value and the claimed Average Lather Value. There is no requirement that the compositions provided in Examples 1-8 list the Average Lather Volume or the Brookfield Yield Value. As a result, claim 1 is fully supported by the specification, and the Examiner has provided no reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. Accordingly, the rejection under §112, ¶1 is believed to be traversed and reconsideration is respectfully requested.

Antecedent Basis 112, ¶ 2

Claims 3, 4, 6, 9, 17 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3 and 4, which depend from claim 1, were rejected for the recitation of "the alkyl substitution" since claim 1 does not require an alkyl substitution. Claims 3 and 4 have been amended to recite that the alkyl ethoxylated polymer comprises at least one alkyl substitution, thus claims 3 and 4 include sufficient antecedent basis.

Claim 6 was rejected for the claim element "the number of the moles of ethylene oxide". Claim 6 has been amended to recite that the alkyl ethoxylated polymer comprises greater than 40 moles of ethylene oxide, thus claim 6 contains sufficient antecedent basis.

Claim 9, which depends on claim 1, was rejected for the claim element "co-polymers", specifically based on Examiner's assertion that claim 9 requires 2 co-polymers whereas claim 1 requires only 1 co-polymer. Claims 1 and 9 have been amended to be consistent, and each claim encompasses one or more co-polymers, thus claim 9 contains sufficient antecedent basis.

Claim 9, which depends on claim 1, was rejected for the claim element "co-polymers", specifically based on Examiner's assertion that claim 9 implies 2 co-polymers whereas claim 1

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implies only 1 co-polymer. Claims 1 and 9 have been amended to be consistent, and each amended claim encompasses one or more co-polymers, thus claim 9 contains sufficient antecedent basis.

Claim 17, which depends on claim 1, was rejected for the claim element "the surfactants". Claim 17 has been canceled, thus the rejection is moot and believed to be overcome.

Claim 18, which depends on claim 1, was rejected for the claim element "anionic lathering surfactants selected from the group", specifically based on Examiner's assertion that claim 18 requires 1 surfactant whereas claim 18 requires at least 2 anionic lathering surfactants not required in claim 1. Claims 1 and 18 have been amended to be consistent, and each claim encompasses one or more surfactants, thus claim 18 contains sufficient antecedent basis.

Accordingly, the rejections under §112, ¶2 are believed to be traversed and reconsideration is respectfully requested.

Rejections under 35 USC § 103

Claims 1, 2, 3, 5, 9 and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Date et al (US 5,674,509) in view of Fair et al (US 5,869,441) and Schmucker-Castner et al (US 6,635,702). Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Date et al (US 5,674,509) in view of Fair et al (US 5,869,441) and Schmucker-Castner et al (US 6,635,702) as applied to claims 1, 2, 3, 5, 9 and 15-19, and further in view of McKelvey et al (US 6,589,517). These rejections are respectfully traversed.

Date is directed to skin care compositions comprising oil in water dispersions and a silicone gum. (*See* Abstract). In Example 1, Date teaches a composition with 0.1% steareth-100, 0.095% Carbopol 1342 and 0.090% Carbopol 951, and 3.3% dimethicone. (Example 1, Col. 10). Date is also cited for teaching Arlatone, which is a composition comprising sucrose cocoate and sorbitan stearate; however, as disclosed in the present specification, Arlatone 2121 is a sucrose ester surfactants, which is considered to a nonionic surfactant. (Page 11, 13-19). Consequently,

Date fails to teach a lathering surfactant comprising a mixture of anionic lathering surfactants, amphoteric lathering surfactants, and zwitterionic lathering surfactants, wherein the lathering surfactant has a ratio by weight of anionic lathering surfactant to amphoteric lathering and zwitterionic lathering surfactants from about 1.5:1 to about 1:3 as recited in claim 1. In addition, Date also fails to teach or suggest, *inter alia*, that the Average Lather Volume of said lathering personal cleansing composition is greater than or equal to about 15 ml, and that the lathering personal cleansing composition has a Brookfield Yield Value greater than 50 dyn/cm² as recited in claim 2.

Fair cannot cure these deficiencies, because Fair teaches away from the proposed combination with Date. As stated in *U.S. v. Adams*, 383 U.S. 39, 148 USPQ 479 (1966), one important indicia of nonobviousness is "teaching away" from the claimed invention. Teaching away is the antithesis of art suggesting that the person of ordinary skill go in the claimed direction. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed Cir. 1988). Here, Date is directed to oil-in-water emulsions or dispersions containing one or more distinct emulsified or dispersed oil phases and an essential emulsifier component as well as various optional ingredients. (Col. 2, lines 9-16). These optional ingredients include gelling agents (Col. 6, lines 32-33), for example, the laundry list of gelling agents listed in Col. 8, lines 18-60.

In contrast to the oil in water emulsions of Date, Fair is directed to **homogenously mixed** compositions comprising EDTA-derived surfactants (Abstract; Col. 11, lines 45-48). Fair emphasizes that neutralization of the composition "is necessary to **avoid gelling** of the EDTA derived surfactant. The gelling, which occurs in an aqueous solution, prevents a homogeneous mixing of the ingredients." (Col. 11, lines 45-48). As stated above, Date is directed to oil in water emulsions comprising gelling agents. In direct contrast, Fair emphasizes that gelling must be prevented and emphasizes that homogenously mixed ingredients, not emulsions are the desired structure of the Fair composition. Due to these significant differences, Fair teaches away from the combination with Date, and the person of ordinary skill would not be led to cure the deficiencies of Date by consulting the teachings of Fair.

Schmucker-Castner, which is assigned to Noveon and is narrowly cited for teaching alkali-swellaable acrylate polymers (e.g. Carbopol resins), also fails to cure the above noted deficiencies of Date. Schmucker-Castner fails to teach a lathering surfactant comprising a mixture of anionic lathering surfactants, amphoteric lathering surfactants, and zwitterionic lathering surfactants, wherein the lathering surfactant has a ratio by weight of anionic lathering surfactant to amphoteric lathering and zwitterionic lathering surfactants from about 1.5:1 to about 1:3 as recited in claim 1. By failing to teach the claimed lathering surfactant, Schmucker-Castner also fails to teach or suggest that the Average Lather Volume of said lathering personal cleansing composition is greater than or equal to about 15 ml as recited in claim 1. In fact, as stated in the present specification, the Noveon Carbopol resins are good suspending polymers; however, cleaning compositions comprising these Carbopol resins are generally considered to lather poorly (Page 2, lines 5-7). As a result, Schmucker-Castner also fails to cure the deficiencies of Date.

McKelvey, which is narrowly cited for teaching alkyl substitutes for alkyl ethoxylated polymers, also fails to cure the deficiencies of Date and/or Schmucker-Castner. McKelvey teaches hair compositions comprising cationic surfactants, but fails to teach lathering surfactants comprising a mixture of anionic lathering surfactants, amphoteric lathering surfactants, and zwitterionic lathering surfactants, wherein the lathering surfactant has a ratio by weight of anionic lathering surfactant to amphoteric lathering and zwitterionic lathering surfactants from about 1.5:1 to about 1:3 as recited in claim 1. By failing to teach the claimed lathering surfactant, McKelvey also fails to teach or suggest that the Average Lather Volume of said lathering personal cleansing composition is greater than or equal to about 15 ml as recited in claim 1.

Accordingly, the rejections under §103 are believed to be overcome and reconsideration is respectfully requested.

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CONCLUSION

Applicants respectfully submit that the currently pending claims represent allowable subject matter. The Examiner is encouraged to contact the undersigned to resolve efficiently any formal matters or to discuss any aspects of the application or of this response. Otherwise, early notification of allowable subject matter is respectfully solicited.

Respectfully submitted,
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